

REMARKS

Claims 1-18 are pending. No new matter has been added.

Statement of the Substance of the Interview

The undersigned held an telephonic interview with the Examiner on April 12, 2007 to discuss the instant case. The undersigned discussed a possible amendment to claim 1 to further clarify that claim 1 recites a "intramedullary nail," which is a device to be inserted into the intramedullary canal to, *inter alia*, provide support to fractures of long bones. (See paragraphs [0002]-[0006], [0008], [0010] of the present application). The Examiner and the undersigned did not discuss if, or how, any proposed amendment would overcome any of the prior art of record. The undersigned simply wished to explore the possibility of clarifying the meaning of the term "intramedullary nail," as consistent with the specification of the present application.

Rejections under 35 U.S.C. § 102(b)

Claims 1, 2, 7, 9, 13, 14, and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,626,613 to Schmieding ("Schmieding"). Applicants submit these rejections should be withdrawn.

Claim 1 recites an osteosynthetic device comprising an "intramedullary nail." Schmieding does not disclose an intramedullary nail. Examiner, however, asserted that "examiner believes the device of Schmieding is capable of being used as an intramedullary nail in the bone of an organism smaller than a human," and again rejected claim 1 under 35 U.S.C. § 102(b). As discussed more fully herein, not only does Schmieding fail to describe an "intramedullary nail," Examiner's reasons for upholding the rejection of claim 1 are unfounded.

In order for an invention to be anticipated under 35 U.S.C. § 102, all the limitations of the claimed invention must be disclosed within a single prior art reference. *Merck & Co. Inc. v. Teva Pharmaceuticals USA, Inc.*, 68 U.S.P.Q 2d 1857, 1861 (Fed. Cir. 2003) ("An 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference"); *In re Paulsen*, 31 U.S.P.Q 2d 1671, 1673 (Fed. Cir. 1994) ("A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference."). In other words, to anticipate claim 1, Schmieding itself must in fact disclose an "intramedullary nail." It does not. Schmieding discloses a suture anchor that secures soft tissue to bone. The Schmieding suture

anchor is adapted to form a helical tunnel in the bone, and then contract to a diameter smaller than that of the formed tunnel, accordingly locking itself within the bone. (*See id.* at 3:61-4:8). Schmieding does not disclose a device to be inserted into the intramedullary canal to, *inter alia*, provide support to fractures of long bones. (*See* paragraphs [0002]-[0006], [0008], [0010] of the present application). Therefore, because the Schmieding reference does not disclose each and every element of claim 1, Schmieding does not anticipate claim 1.

Examiner's arguments in support of maintaining the rejection of claim 1 as anticipated by Schmieding are unfounded, and cite irrelevant caselaw. First, Examiner cites *In re Casey*, 152 U.S.P.Q. 235 (C.C.P.A. 1967) and *In re Otto*, 136 U.S.P.Q. 458 (C.C.P.A. 1963) for the proposition that statements of intended use and functional statements do not impose any structural limitations on the claims. (Final Office Action at 4). This argument and caselaw are not relevant to claim 1 because claim 1 affirmatively recites that the osteosynthetic device *comprises* an "intramedullary nail." This is not a functional limitation. Claim 1 states what the osteosynthetic device *is*. Examiner's argument is also off-base because *Casey* and *Otto* deal with obviousness rejections. *Casey*, 152 U.S.P.Q. at 237; *Otto*, 136 U.S.P.Q. at 459. In this case, the Examiner is asserting that Schmieding *anticipates* claim 1, thereby rendering any statements regarding functional language found in *Casey* or *Otto* inapplicable.

Second, Examiner cites *Ex parte Masham*, 2 U.S.P.Q. 2d 1647 (Bd. Pat. App. & Int. 1987) for the proposition that the manner in which a device is intended to be used does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. (Final Office Action at 5). In *Masham*, the Board found appellant's apparatus anticipated by the prior art when the reference was factually determined to be capable of functioning as the claimed invention, and when the only difference between the claimed invention and the reference was the instructions on how they were to be used. 2 U.S.P.Q. 2d at 1647. In contrast, Schmieding differs from Applicants' claimed invention not only in terms of intended use, but also in the structural limitation that Applicants' claimed invention comprises an "intramedullary nail." Schmieding discloses a suture anchor which is clearly not a device to be inserted into the intramedullary canal to, *inter alia*, provide support to fractures of long bones. (*See* paragraphs [0002]-[0006], [0008], [0010] of the present application). Thus, *Masham* presents a distinguishable scenario as well

As Schmieding fails to disclose an intramedullary nail, Applicants respectfully submit that the rejection of claim 1 should be withdrawn. As claims 2, 7, 9, 13, 14, and 17

depend on claim 1, Applicants respectfully submit that the rejections of these claims should be withdrawn as well, for at least this reason.

Rejections under 35 U.S.C. § 103

Claims 3-6, 8, 10-12, 15-16, and 18 were rejected under 103(a) as being unpatentable over Schmieding. Independent claim 1 is not obvious in light of Schmieding because Schmieding does not teach, suggest, or describe an intramedullary nail, as discussed above. As claims 3-6, 8, 10-12, 15-16, and 18 depend on claim 1, the Applicants respectfully submit that the rejections of these claims should be withdrawn.

CONCLUSION

It is believed that claims 1-18 are in condition for allowance. Should the Examiner not agree with Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues.

No fee is believed to be due for this response. Should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Account No. 503013.

Respectfully submitted.

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